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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,518	03/22/2000	Jennifer Newnam	109.779.114	2014

7590 11/18/2003

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/536,518

Applicant(s)

NEWNAM ET AL.

Examiner

Raquel Alvarez

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2002 and 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 9/25/2003.
2. Applicant elected invention I (claims 1-16) without traverse.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over article titled, "NetPlay: NetPlay Debuts Internet's Premier Multi-Player Entertainment Network; Netplay Game Club Brings People Together to Create Broad-Bases, Online Community" (hereinafter NetPlay).

With respect to claims 1-3 , NetPlay teaches an electronic network so that multiple users can compete in a skill-based contest (entire document). Identifying a set of contestants (see page 1, 4th paragraph); grouping the set of contestants into group subsets according to group criteria (see page 2, 3rd paragraph); matching contestants within a group subset into subcompetitions (i.e. each age group will be presented with a game according to their ages and knowledge)(page 1, paragraphs 5th and 6th); for each group subcompetition, electronically presenting a competition task (pages 1 and 2); monitoring responses to the competition task from each subcompetition and determining a subcompetition outcome status of each contestant in the subcompetition (i.e. players win points which can be redeemed for prizes)(page 2).

With respect to the contestant being a large multitude. Official notice is taken that it is old and well known to include a large number of contestants in order to make the competition more fiercely. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a large multitude of contestants in order to achieve the above mentioned advantage.

With respect to grouping at least some of the contestants according to the subcompetition outcome status and repeating the monitoring and grouping of the contestants outcome status until there is a unique winner in a fixed, short amount of time after the fixed start time. NetPlay teaches on page 1,4th paragraph that the players can become the ultimate star of the contest by playing in tournaments for additional prizes and since Netplay is computer implemented therefore the outcome of the winner to be performed in a short amount of time is obvious in order to keep excitement within the game. It is also old and well known in world series games, such as baseball and the like to repeat the monitoring of the outcome of the games and then to re-group the winners into a tournament in order to obtain the world championship winner. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included repeating the steps of monitoring and grouping the winners until there is a unique winners because such a modification would allow in the system of NetPlay for players to compete with others winners.

Claims 4, and 12 further recite enforcing a time deadline for the receipt of the response in order to consider the response as valid. Official notice is taken that it old and well known in any competition such as spelling-bee and the like to enforce a time

deadline for the receipt of the response. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included enforcing a time deadline for the receipt of the responses because such a modification would allow to equally evaluate the members based on the same time frame.

The limitations of claim 5 were previously addressed in the rejection to claim 1 addressed above and therefore is rejected under similar rationale.

The limitations of claim 6 were previously addressed in the rejection to claim 4 addressed above and therefore is rejected under similar rationale.

With respect to claims 7, the limitations were previously addressed in the rejections to claims 6 and therefore rejected under similar rationale.

With respect to claims 8-11, in addition to the limitations previously addressed in the rejection to claims 6-7 addressed above, the claims further recite recording responses to create profile information, demographic and psychographic information . Official notice is taken that it is old and well known in marketing to collect information on the costumers in order to create profile, demographic and psychographic information which is often used to target advertisements and products to the customers based on their responses. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included creating profile, demographic and psychographic information with the responses collected from Netplay in order to obtain the above mentioned advantage.

With respect to claims 13-14, in addition to the limitations previously addressed in the rejections to claims 6-7 addressed above, the claims further recite that the prizes include click on electronic coupons. Netplay teaches that members are awarded prizes (page 1). Netplay is silent as to the content of the prizes. Official notice is taken that it is old and well known in marketing to award click on electronic coupons to computers users to induce purchasing. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the prizes of Netplay to include click-on coupons in order to obtain the above mentioned advantage.

With respect to claim 15, in addition to the limitations previously addressed in the rejections to claims 6-7 addressed above, the claims further recite that the competition tasks include branded questions. Official notice is taken that it is old and well known for questions to include branded questions as part of a competition in order to test the customers knowledge on the subject. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included that the competition tasks include branded questions in order to obtain the above mentioned advantage.

With respect to claim 16, in addition to the limitations previously addressed in the rejections to claims 6-7 addressed above, the claims further recite awarding points that are redeemable for prizes. Official notice is taken that it is old and well known to award points for prizes. For example, certain retailers will award points for purchase which can be redeemed for prizes to motivate the customers to make purchases within the

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establishment. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included awarding points that can be redeemable for prizes in order to obtain the above mentioned advantage.

Response to Arguments

4. The Examiner is making this action non-final because some of the claims were not previously addressed.

The examiner disagrees with Applicant that Netplay does not teach selecting an unique winner. The Examiner asserts that Netplay teaches a tournament in which players are eligible for prizes. A tournament in itself is a competition which produces a winner.

The Applicant argues that Netplay doesn't teach a large multitude of players. The Examiner asserts that changing the size is obvious. See *In re Rose*, 105 USPQ 237, 240; 220 F2d 459 (CCPA 1955)

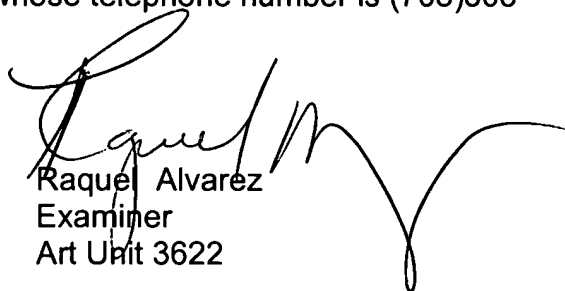
The examiner reviewed the declaration and the articles presented by the Applicant. The Examiner wants to point out that the claims were not and are not rejected under 102. The claims were instead rejected under 103 and the modifications to the claims were considered to be within the level of ordinary skill in the art.

Point of contact

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Raquel Alvarez
Examiner
Art Unit 3622

R.A.
11/12/03